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IN THE

Supreme Court of the United States

October Term, 1975

PANDUIT CORP.,

Petitioner,

v.

BURNDY CORPORATION and
BURNDY MIDWEST, INC.,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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Introduction

In this action for patent infringement between two private corporations, Petitioner seeks a review of the decision of the court below which held the patent in suit was invalid for "obviousness" under 35 U.S.C. 103.

Petitioner is asking this Court to once again go over the well-trodden path of 35 U.S.C. §103, which it has already reviewed in considerable depth in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), and later in *Anderson's-Black Rock* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969).

Statement

The patent in suit relates to a mechanical tool for applying binder straps. The tool, which consists of a combination of old elements, merely eliminates a component and its function which was made unnecessary and obsolete due to advances in the binder strap industry. The court below, applying the standards set forth in *Graham* and referring to an 1895 decision by this Court, *Richards* v. *Chase Elevator Co.*, 159 U.S. 477 (1895), correctly held that such elimination of an obsolete part from a prior device was "obvious" and the patent, accordingly, was invalid.

The petition does not present any new questions of law nor any questions involving public policy. Petitioner merely seeks another chance again to argue the validity of its patent.

Reasons for Opposition

Petitioner incorrectly argues that this Court in *Black Rock* has in some manner created an uncertainty in applying the standards for determining obviousness as set down in *Graham*. There is no basis for this contention, and the court below did not exhibit any uncertainty in applying the proper *Graham* standard in reaching its decision.

As quoted by the court below and by this Court in *Black Rock*, *Graham* established the following procedure to determine whether an invention is "obvious" and thus unpatentable under 35 U.S.C. 103:

> The scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

A determination of obviousness or nonobviousness, according to *Graham*, is thus made against the factual background of the patented subject matter. In the present case, as it was in *Black Rock*, the patented device consisted of a combination of old elements.

In finding that the combination was an "obvious" one, one factor considered in *Black Rock* and by the appellate court below, was that the combination did not produce "a new or different function". This, however, has been a guide for evaluating the patentability of combination patents at least since 1938 when this Court rendered its decision in *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545 (1938) and repeated in *A & P Tea Co.* v. *Supermarket Equip. Co.*, 340 U.S. 147 (1950).

The *Black Rock* test of whether a patented combination produces a "new or different function" is thus not an addition or modification of the statutory standard of "obviousness"; it is merely a guide for assisting the courts in determining whether or not the patented combination is "obvious". This test, which stands as a complement to the *Graham* criteria, was correctly applied by the appellate court, along with the other *Graham* criteria, in determining that the patented combination was obvious.

Neither the court below nor this Court in *Black Rock* made the producing of a "synergistic" result a requirement for patentability. This was referred to in *Black Rock* as an additional criterion that could be used in determining obviousness. This criterion, however, was not considered by the appellate court, and thus has no relevancy here.

Conclusion

The court below properly applied the standards for patentability that this Court established in *Graham* and supplemented in its decision in *Black Rock* concerning combination patents. There is no reason for this Court to review the appellate court's holding of invalidity, and it is accordingly submitted that the Petition for Certiorari be denied.

Respectfully submitted,

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